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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,499	10/13/2000	Christopher C. Winslade	0020	1146

7590 01/27/2011  
Christopher C. Winslade  
500 West Madison St. 34th Floor  
Chicago, IL 60661

EXAMINER
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RETTA, YEHDEGA

ART UNIT	PAPER NUMBER
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3622

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/687,499	<b>Applicant(s)</b> WINSLADE ET AL.	
	<b>Examiner</b> Yehdega Retta	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 34-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This office action is in response to amendment filed November 23, 2010. Claim 34 has been amended. Claims 34-39 are pending.

#### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 34 and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Meyer et al. (US 6,915,271).

Regarding claim 34, Meyer teaches offering by a second system of a second party (the service provider that runs the incentive system) items for sale at a sales price amount (items that are sold at the websites) wherein the item for sale can be identified by a customer using the second system (the incentive system website where the merchants sites such as Target, Holt, EB, amazon.com etc, circuit city are included (see fig. 31-35, col. 16 lines 1-5, col. 39 line 55 to col. 41 line 22); providing, by the second system, a portal containing a plurality of promotions wherein a buyer can search for a promotion from the first party associated with the item for sale (promotions from Target or Holt or amazon.com etc.,) (see fig. 31 and col. 16 lines 6-67, see col. 38 line 60 to col. 40 line 67; wherein the customer can search for the promotion after the customer has identified the item for sale on the second system, the promotion having a promotion amount (fig. 19-34, col. 45 lines 19-44); receiving, by the second system (service provider or the incentive system), online purchase request from customer for at least one item

Art Unit: 3622

(buy now) (see col. 40 line 64 to col. 41 line 40); responding, by the second system, to the online purchase request by collecting from the customer a purchase amount corresponding to the sales price amount less the promotion amount (see col. 41 line 66 to col. 42 line 25) and electronically communicating, by the second system to the first system, an indication regarding the collection from the customer of the purchase amount (see col. 40 line 64 to col. 41 line 40, col. 42 line 1-64, col. 49 lines 40 to col. 50 line 7).

Regarding claim 35, Meyer teaches offering, by a second system of a second party, an item for sale online at a sales price amount (see fig. 33 and 35 also col. 40 line 64 to col. 41 line 40), the item for sale having associated with it, by the second system of the second party, a promotion from the first party, the promotion having a promotion amount wherein the second system is distinct from the first system and the second party is distinct for the first part ((see fig. 33 and 35 (\$5 off, Free Beanie Baby with Toy Purchases etc); receiving, by the second system, an online purchase request from a buyer for the item for sale (see col. 40 line 64 to col. 41 line 21 and col. 42 lines 1-36) responding, by the second system, to the online purchase request by collecting from the buyer a purchase amount corresponding to the sales price amount less the promotion amount (see col. 42 lines 1-36); and causing, by the second system, shipment by the second party of the item for sale to the buyer (see col. 41 lines 22-40).

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer et al. (US 6,915,271) in view of Murphy et al. (US 2002/0052778 A1).

Regarding claims 36-38, Meyer teaches offering, by a second system of a second party, an item for sale online (see fig. 33 & 35 isavings), wherein the item has been acquired by the second party from the first-party (customer purchasing the items at the second party (promotional site)(see col. 40 line 67 to col. 41 line 2), the item for sale having associated with it a promotion from the first party, the promotion having a promotion amount (see fig. 33 and 35 (\$5 off, Free Beanie Baby with Toy Purchases etc); receiving, by the second system, an online purchase request from a buyer for the item for sale (see col. 40 line 64 to col. 41 line 21 and col. 42 lines 1-36); receiving, by the second system, an online purchase request from a buyer for the item for sale (see col. 40 line 64 to col. 41 line 21 and col. 42 lines 1-36); responding, by the second system, to the online purchase request by collecting from the buyer a purchase amount corresponding to a sales-price amount less the promotion amount (see col. 42 lines 1-36). Meyer does not teach collecting, by the second system, a service fee from the buyer, it is taught in Murphy (see [0015]-[0018]). It would have been obvious to one of ordinary skill in the art at the time of the invention to collect fee from the buyer as in Murphy in order to demonstrate the user's level of interest to the manufacturer or charge for the service provided by the second party.

Claims 36 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer et al. (US 6,915,271) in view of Holda-Fleck (US 5,729,693).

Regarding claims 36 and 39, Meyer teaches offering, by a second system of a second party, an item for sale online (see fig. 33 & 35 isavings), wherein the item has been acquired by the second party from the first-party (customer purchasing the items at the second party

Art Unit: 3622

(promotional site)(see col. 40 line 67 to col. 41 line 2), the item for sale having associated with it a promotion from the first party, the promotion having a promotion amount (see fig. 33 and 35 (\$5 off, Free Beanie Baby with Toy Purchases etc); receiving, by the second system, an online purchase request from a buyer for the item for sale (see col. 40 line 64 to col. 41 line 21 and col. 42 lines 1-36); receiving, by the second system, an online purchase request from a buyer for the item for sale (see col. 40 line 64 to col. 41 line 21 and col. 42 lines 1-36); responding, by the second system, to the online purchase request by collecting from the buyer a purchase amount corresponding to a sales-price amount less the promotion amount (see col. 42 lines 1-36). Meyer does not teach collecting, by the second system, a service fee from the buyer, it is taught in Holda-Fleck (see col. 3 lines 23-44). It would have been obvious to one of ordinary skill in the art at the time of the invention to collect fee from the first party, as in Holda-Fleck, in order to charge for the service provided by the second party, as taught in Holda-Fleck.

### **Response to Arguments**

Applicant's arguments filed November 23, 2010 have been fully considered but they are not persuasive.

According to applicant specification the user (online buyer) uses the client computer (fig. 1 (5)) to interact with an online rebate and coupon dispenser and redeeming system (15) (associated with a web server 20) (system 15, 20 or 25). Claim 34 however recites that the item can be identifies on the second system by **a consumer using the second system**. It is unclear to the Examiner if the user uses the client computer to identify the item, i.e., by accessing the second system, or uses the second system (that is without using the client computer).

Art Unit: 3622

Examiner withdraws the 112 rejection on the assumption that the user, using the client computer, identifies the item by accessing the second system. Examiner's interpretation of "by using the second system" is "by accessing the second system". Based on this interpretation the 112 rejection is withdrawn.

Regarding claim 34, applicant argues that the Office Action relies on "Target Holt EB, Amazon.com" for example as second system, however the promotion in those examples are from the same entities. Applicant provides example that the second system offering items for sale online and promotions coming from a distinct first party. As indicated above the second system which provides items for sale is now the service provider, which provides the incentive system (where the merchants (first entity distinct from the incentive system) are included. Even though the claim does not recite that the second entity is different from the first entity, Meyer also teaches the promotion is provided by the first entity which is distinct from the second entity (the incentive system). Applicant asserts claim 34 is amended to more clearly specify that the portal **provided after the item is selected** is provided by the second system and indicates that the second system providing a portal after item is selected for sale (the system 15 returns coupons for multiple manufacturers of similar products for the customer to choose from).

Examiner points out that the claim recites as follows:

**providing, by the second system, a portal containing a plurality of promotions** wherein the customer can search for a promotion from the first party associated with the item for sale, **wherein the customer can search for the promotion after the customer has identified the item for sale on the second system, the promotion having a promotion amount;**

**receiving, by the second system an online purchase request from the consumer for the item for sale**

Art Unit: 3622

The claim however does not recite that the portal is provided after the item is selected or selected for sale. The claim recites wherein the customer can search for the promotion after the customer has identified the item for sale.

Meyer teaches the second system providing item for sale and also plurality of promotions. All the item displayed on the second system are identified by the customer (seen or recognized by the user) and the user can search (look for) an item with a discount that is he/she prefers.

Regarding claim 35, Applicant argues regardless of whether information is collected to complete the purchase, "informing the vendor of the transaction, giving the vendor all information necessary for the vendor to fulfill the purchase" does not teach "causing, by the second system, shipment by the second party ...".

The claim recites causing, by the second system, shipment by the second party of the item for sale to the buyer. The claim recites causing by the second system shipment of the item but does not positively recite the second party shipping the item (i.e., the item is directly shipped by the second system of the second party) . Meyer also teaches the second system (of the second party) causing the shipment of the item (see col. 41 lines 22-40).

Regarding claim 36, Applicant previous argument was that the site offering an item may not have yet acquired the item or may not ever acquire the item at all. Since the term acquire can mean different thing (for example the definition of "acquire" is to obtain, get hold of, attain, buy or purchase etc) it is unclear if applicant mean for the second party to physically obtain the item from the first party or to just have . As indicated before, if applicant by acquiring means that the item has to be fiscally acquired by the second party from the first part, then the merchants in



Art Unit: 3622

Meyer are the second party and the manufactures are the first party. Meyer teaches the issuer of the incentive for example the identification of the manufacturer or supplier of the goods or services is for a product (goods or services to which the incentive applies) is entered. The goods or services to which the incentive applies are sold by different entities (which in this case are the second party) which provide the item for sale (which are also different and distinct entities). Meyer teaches that the consumers find displays of incentives (or icons that generate incentive icons) in a variety of places on the Internet: manufacturer Web sites where products are described; retailer Web sites where products are sold; affinity Web sites for special interests such as entertainment, etc., (see col. 22 line 43 to col. 28 line 5). Clearly, Meyer teaches the retail Web sites (second party) offering items for sale (items acquired from the manufacturer or suppliers) (first party) having associated with it manufacturer's promotion (issuers).

### Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 3622

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/  
Primary Examiner, Art Unit 3622